

Application Serial No.: 09/741,297

REMARKS

In the above-referenced Office Action, the Examiner rejected claims 20-31 and withdrew claims 32-41 from consideration. This submission cancels claims 20-41 without prejudice to, or disclaimer of, the subject matter of these claims and adds new claims 42-55. After entry of the foregoing amendments, claims 42-55 (2 independent claims, 14 total claims) remain pending in the application. Reconsideration is respectfully requested.

Election/Restriction

In view of the current amendment to the claims, Applicant believes that any outstanding requirement for restriction and election is hereby rendered moot. Applicant further believes that newly submitted claims 42-55 are directed to a single invention.

Rejections under 35 U.S.C. § 112, ¶ 2

Claims 20-31 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as their invention. Applicant respectfully traverses this rejection.

Applicant submits that this rejection has been rendered moot by the cancellation of the rejected claims and the fact that the newly submitted claims do not contain the alleged defects. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejections under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 112, ¶1: Written Description

Claims 20-31 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the invention. Applicant respectfully traverses this rejection.

Applicant submits that this rejection has been rendered moot by the cancellation of the rejected claims and the fact that the newly submitted claims do not contain the alleged defects. Further, descriptive support for newly added claims 42-55 can be found in the

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specification, *inter alia*, at page 3, paragraph 2; page 5, paragraph 5; page 12, paragraph 5; page 13, paragraph 3; and Tables 2 and 3.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 112, ¶1: Enablement

Claims 20-31 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled by the specification. The Examiner contends that the specification does not reasonably provide enablement for "unspecified conditions which inhibit *Agrobacterium* induced necrosis (AIN), or the broad scope of inhibiting agents or inhibitors." Office Action, p. 5, ¶ 6. Applicant respectfully traverses this rejection.

Applicant submits that this rejection has been rendered moot by the cancellation of the rejected claims and the fact that the newly submitted claims do not contain the alleged defects. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 102: Key *et al.*

Claims 20-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Key *et al.*, U.S. Patent. No. 5,447,858, issued September 5, 1995 ("Key"). Applicant respectfully traverses this rejection.

Applicant submits that this rejection has been rendered moot by the cancellation of the rejected claims. Applicant's claimed invention is directed to methods for transforming a plant cell or tissue susceptible to *Agrobacterium* Induced Necrosis (AIN) with a nucleotide sequence of interest, comprising "co-cultivating *Agrobacterium* comprising a nucleotide sequence of interest with a plant cell or tissue in a medium which contains an AIN inhibitor consisting of silver nitrate." Applicant respectfully submits that Key does not disclose the claimed subject matter.

Accordingly, the claimed invention is not anticipated by Key, and Applicant, therefore, respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b).

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Applicant submits that this rejection has been rendered moot by the cancellation of the rejected claims. Applicant respectfully submits that Ryals does not disclose the claimed subject matter and, therefore, does not anticipate the claimed invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b).

Rejection for Obviousness-Type Double Patenting

Claims 20-31 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-48 of U.S. Patent No. 6,162,965.

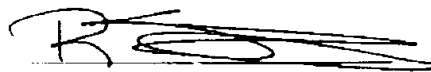
Applicant submits that this rejection has been rendered moot by the cancellation of the rejected claims and submission of the new claims. New claims 42-55 are patentably distinct from, and not rendered obvious by, the claims of the '965 Patent.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

CONCLUSION

Pursuant to the foregoing remarks, Applicant respectfully submits that all of the pending claims fully comply with 35 U.S.C. § 112 and are allowable over the prior art of record. No new matter is added by this amendment. Reconsideration of the application and allowance of all pending claims is earnestly solicited. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to telephone the undersigned at the Examiner's convenience. Entry of the amendments is respectfully requested.

Respectfully submitted,



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Date: September 29, 2003